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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/630,048

07/30/2003

Heiko Rommelmann

D/A3255

8184

25453

7590

06/27/2006

PATENT DOCUMENTATION CENTER

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EXAMINER

PATEL, NITIN C

ART UNIT

PAPER NUMBER

2116

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/630,048	ROMMELMANN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Nitin C. Patel	2116	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/30/03</u> . | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

1. This is in responsive to communication filed on 27 December 2004.
2. Claims 1 – 20 are presented for the examination.

#### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 30 July 2003 was filed before the mailing date of the first office action. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

#### ***Specification***

4. The disclosure is objected to because of the following informalities:
5. On page 1, line 2, replace "Attorney Docket Number D/A3028" with the appropriate U.S. Application Serial No.
6. On page 1, line 5, replace "Attorney Docket Number "D/A3245" with the appropriate U.S. Application Serial No.

#### ***Claim Objections***

7. Claims 4, 10, and 18 are objected to because of the following informalities:
8. Claim 4, recites the limitation "CRUM" on line 1, of page 14. The abbreviation of term "CRUM" is required or defined at least once in claim.
9. Claim 10, recites the limitation "CRUM" on line 1, of page 15. The abbreviation of term "CRUM" is required or defined at least once in claim.
10. Claim 18, recites the limitation "CRUM" on line 1, of page 16. The abbreviation of term "CRUM" is required or defined at least once in claim.

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Appropriate correction is required.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1 – 20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 20 of copending Application No. 10/447,737, and 10/630, 076. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

12. The independent claim 1, of current application is identical to the claim 1 of pending applications No. 10/447,737, and 10/630, 076 except the wireless interface and reading [accessing] memory via wireless interface which is taught by applicant admitted prior art Us Patent 6,351,621 in para 0008 on page 1 of pending applications.

13. The independent claim 7, of current application is identical to the claim 7 of pending applications No. 10/447,737, and 10/630, 076 except the wireless interface and reading [accessing] memory via wireless interface which is taught by applicant admitted prior art Us Patent 6,351,621 in para 0008 on page 1 of pending applications.

14. The independent claim 16, of current application is identical to the claim 16 of pending applications No. 10/447,737, and 10/630, 076 except the wireless interface and reading [accessing] memory via wireless interface which is taught by applicant admitted prior art Us Patent 6,351,621 in para 0008 on page 1 of pending applications.

15. The dependent claims 2 – 6 of current application are exactly identical to the claims 2 - 6 of pending applications No. 10/447,737, and 10/630, 076.

16. The dependent claims 7 – 15 of current application are exactly identical to the claims 7 - 15 of pending applications No. 10/447,737, and 10/630, 076.

17. The dependent claims 17 – 20 of current application are exactly identical to the claims 17 - 20 of pending applications No. 10/447,737, and 10/630, 076.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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18. Claims 1 – 10, and 14 – 20 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Richards et al. [hereinafter as Richards], US Patent 6,351,621 B1 [cited in IDS by applicant].

19. As to claim 1, Richards discloses a method for managing machine operation options and configuration comprising:

a. providing a software operation key separable [replaceable module] from the machine, the software operation key further comprising a wireless interface [30, RF loop][col. 5, lines 48 – 50], a memory [34], the memory further comprising a programmable serial region and an option code [col. 6, lines 53 – 67];

b. placing [attaching] the software operation key [replaceable module] into the machine [10, printer];

c. reading via the wireless interface the programmable serial region of the memory [col. 6, lines 14 – 19] and if found blank, initializing [resetting] with a machine identification number [serial number, col. 4, lines 16- 21, col. 6, lines 35 – 39, 53 – 67];

d. comparing [inherent to determine the machine compatibility] the content of the programmable serial region if not blank with the machine identification number [col. 4, lines 16 – 21, 47 – 67];

e. reading the memory via the wireless interface and placing the option code into the machine [col. 6, lines 17 – 20]; and,

f. operating the machine [10] in accordance with the option code [update performance][col. 2, lines 45 – 63, col. 4, lines 16 – 20, 47 – 67, col. 5, lines 42 – 67, col. 6, lines 1 – 67, col. 7, lines 1 – 30].

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20. As to claim 7, Richards, discloses a printing machine [10, printer] comprising:

- a. a software operations key separable [replaceable module] from the machine, further comprising a wireless interface [30, RF loop] and a memory [34], the memory having at least an option code region [as shown in fig. 2], and a one time programmable serial region [as shown in fig. 2];
- b. an option code written into the option code region of the memory suitable for directing the printing machine to operate in a particular configuration [col. 5, lines 7 – 20, col. 6, lines 27 – 45]; and,
- c. a control system to access the one time programmable [retained] serial region [location] of the memory via the wireless interface and determine thereby if the option code in the option code region [location] of the software operations key should be used to configure the printing machine [col. 2, lines 45 – 63, col. 4, lines 16 – 20, 47 – 67, col. 5, lines 42 – 67, col. 6, lines 1 – 67, col. 7, lines 1 – 30].

21. As to claim 16, Richards, discloses a software operations key [replaceable module] for setting the option configuration of a machine [col. 4, lines 48 – 52] and separable [replaceable] from that machine [10, printer], comprising:

- a. a wireless interface [30, RF loop][col. 5, lines 48 – 55],
- b. a memory [34], the memory having at least: an option code region [fig. 2], and a one time programmable serial region [retainable or never be changed or leave unchanged, col. 4, lines 16 – 20, col. 6, lines 53 – 67, fig. 2]; and, an option code written into the option code region of the memory suitable when accessed via the wireless

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interface, for directing the machine to operate in a particular configuration [with different performance data parameters] [col. 5, lines 7 – 20, col. 6, lines 7 – 67].

22. As to claim 2, Richards, discloses the machine is a printer [10][col. 3, line 22, fig. 2].

23. As to claim 3, Richards discloses the machine is a multi-function office device [col. 3, lines 32 – 36].

24. As to claims 4, and 17, Richards discloses the memory is a non-volatile memory including an EEPROM [col. 4, lines 5 – 7].

25. As to claims 5, and 18, Richards, discloses the software operation key is a CRUM [col. 4, lines 5 – 7].

26. As to claim 6, Richards, discloses the machine identification number is a machine serial number [col. 4, lines 16 – 20].

27. As to claims 8 – 9, Richards, discloses the memory is a non-volatile memory including an EEPROM [col. 4, lines 5 – 7].

28. As to claim 10, Richards discloses the non-volatile memory is a CRUM [col. 4, lines 5 – 7].

29. As to claim 14, Richards, discloses the option code directs the printing machine to configure for different parameters for transfer efficiency, which indirectly teaches a faster operation [col. 6, lines 43 – 46].

30. As to claim 15, Richards, discloses the option code directs the printing machine to configure for job based accounting [print counts for cumulative use and/or maximum number of prints allowed][col. 6, lines 7 – 12].



31. As to claims 19 and 20, Richards discloses the one time programmable [retainable or never be changed or leave unchanged] serial region has a machine identifier including the machine serial number [col. 4, lines 16 – 20, col. 6, lines 53 – 67].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

32. Claims 11 – 13 are rejected under 35 U.S.C. 103(a) as being obvious over Tabb et al. [hereinafter as Tabb], US Patent 6, 735,399 B2.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing

that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

33. As to claims 11 – 13, As to claim 7, Richards, discloses a printing machine [10, printer] comprising: a software operations key separable [replaceable module] from the machine, further comprising a wireless interface [30, RF loop] and a memory [34], the memory having at least an option code region [as shown in fig. 2], and a one time programmable serial region [as shown in fig. 2]; an option code written into the option code region of the memory suitable for directing the printing machine to operate in a particular configuration [col. 5, lines 7 – 20, col. 6, lines 27 – 45]; and, a control system to access the one time programmable [retained] serial region [location] of the memory via the wireless interface and determine thereby if the option code in the option code region [location] of the software operations key should be used to configure the printing machine [col. 2, lines 45 – 63, col. 4, lines 16 – 20, 47 – 67, col. 5, lines 42 – 67, col. 6, lines 1 – 67, col. 7, lines 1 – 30].

However, Richards does not teach that the option code directs the printing machine to configure as a scanner, a scan to email mode, and scan to internet fax mode.

Tabb discloses a printing machine [100] with a replaceable sub-assembly [CRU 1] for software code updates including a memory [30] including upgraded executable instructions suitable for directing the machine to use with different types of functionality including as a scanner/fax/copier or printer/copier [col. 1, lines 29 – 31, col. 2, lines 39 – 56, col. 4, lines 50 – 54].

It would have been obvious to one of ordinary skill in art, having the teachings of Richards and Tabb before him at the time of invention was made, to modify the replaceable module code as disclosed by Richards to include an upgraded executable instructions suitable for directing the machine to use the replaceable sub-assembly with different set points to use with different types of functionality including as a scanner/fax/copier or printer/copier [col. 1, lines 29 – 31, col. 2, lines 39 – 56, col. 4, lines 50 – 54] as taught by Tabb in order to obtain an improved methodology for updating machine software code in multi-function machine. One of ordinary skill in the art wanted to be motivated to include executable instructions suitable for directing the machine to use with different types of functionality including as a scanner/fax/copier or printer/copier in replaceable sub-assembly by providing software code updates without need for a field service call, and improves over deficiencies and disadvantages [col. 2, lines 32 – 38].

34. **Examiner's note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

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35. **Prior Art not relied upon:** Please refer to the references listed in attached PTO-892, which, are not relied upon for claim rejection since these references are relevant to the claimed invention.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nitin C. Patel whose telephone number is 571-272-3675. The examiner can normally be reached on 6:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H. Browne can be reached on 571-272-3670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nitin C. Patel  
June 17, 2006



**A. ELAMIN**  
**PRIMARY EXAMINER**